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Date: 1/19/07By: Patti Hespell
Patti HespellMail Stop Appeal Brief - PatentsIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Patent Application of Charles A. Eldering.

Conf. No.: 8089 : Group Art Unit: 2623
Appln. No.: 09/742,852 : Examiner: James R. Sheleheda
Filing Date: 21 December 2000 : Attorney Docket No.: T721-19
Title: System for rescheduling and inserting advertisements

APPELLANTS' BRIEF IN SUPPORT OF THE APPEAL TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES

In response to the non-final Rejection dated March 24, 2006, and the Notice of Pre-Appeal Brief Review dated September 19, 2006, and further to the Notice of Appeal and Request for Pre-Appeal Brief Conference filed on July 21, 2006, Applicants hereby submit an Appeal Brief in accordance with 37 C.F.R. §41.37 for the above-referenced application.

This paper is being timely submitted by virtue of the accompanying Petition for Extension of Time (three-months), which extends the period available for reply through and including January 19, 2007.

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(A) **REAL PARTY IN INTEREST**

The real party in interest is Prime Research Alliance E., Inc., the Assignee of record, which is a wholly owned subsidiary of a privately-owned, non-publicly traded company.

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(B) RELATED APPEALS AND INTERFERENCES

There are no prior or pending appeals, judicial proceedings or interferences known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

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(C) STATUS OF CLAIMS

Claims 1-3, 7-54, 57, 58, 61-74, 76, 77, 80-89 are canceled.

Claims 4-6, 55, 56, 59, 60, 75, 78, 79, 90 and 91 are pending, rejected and are appealed.

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(D) STATUS OF AMENDMENTS

No amendment has been filed subsequent to the non-final rejection.

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The claimed subject matter relates to a method and system of presenting targeted advertisements to a subscriber viewing current program content on a display device (see for example, Figs. 1 and 2, and page 4, line 1 – page 5, line 15, of the specification). A queue having unscheduled targeted advertisements to be presented to the subscriber is generated by an ad scheduler 312 (see, for example, Fig. 3 and page 9, lines 15 – 21; page 18, line 7 – page 19, line 10; and page 29, lines 10 – 23, of the specification), such that the queue indicates the order in which the advertisements are to be presented (see, for example, page 11, lines 9 – 19; and page 18, line 7 – page 19 of the specification). An avail information detector 310 detects and/or indicates an avail, or advertisement space, in the program stream (see, for example, page 8, line 18 – page 9, line 2; page 12, lines 2 – 19; and page 17, lines 5 – 14 of the specification). The targeted advertisements are presented to the subscriber in the detected advertisement space, or avail, in accordance with the order specified by the queue (see, for example, Fig. 4 and page 11, lines 1 – 19; page 13, lines 8 – 21; and page 17, lines 5 – 22 of the specification). An ad processing unit 22 and watchdog module 320 are configured to detect changes in viewing parameters, including program content currently being displayed to the subscriber (see, for example, page 9, line 22 – page 10, line 5; page 16, lines 6 – 8; and page 19, line 4 – page 21, line 5 of the specification). The ad scheduler 312 reorders the queue according to program content displayed as a result of the detected change in viewing parameters (see, for example, page 10, lines 13 – 24; page 19, lines 4 – 20; page 20, lines 4 – 13; and page 29, lines 10 – 23, of the specification).

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(F) GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The following ground of rejection is presented for review in this appeal:

- Whether claims 4-6, 55, 56, 59, 60, 75, 78, 79, 90 and 91 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,698,020 to Zigmond *et al.* ("Zigmond") in view of U.S. Patent Publication No. 2003/0200128 A1 Doherty ("Doherty").

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(G) ARGUMENTS

(1) Rejection under 35 U.S.C. §103(a) over Zigmond in view of Doherty

(a) Claims 4-6, 55, 56, 59, 60, 75, 78, 79, 90 and 91

The Examiner has not established a *prima facie* case of obviousness to support the rejection of claims 4-6, 55, 56, 59, 60, 75, 78, 79, 90 and 91 because (i) the Examiner has not pointed to an objective teaching which suggests the motivation to combine them; and (ii) all features of the claims are not taught by the proposed combination.

i. There Is No Suggestion or Motivation to Modify the References

The Examiner can satisfy the burden of *prima facie* obviousness only by showing an objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art, would lead that individual to combine the relevant teachings of the references in the manner suggested by the Examiner. *See In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1998). The mere fact that the prior art could be modified in the manner proposed by the Examiner, does not make the modification obvious unless the prior art suggests the desirability of the modification. *See Ex Parte Dussaud*, 7 USPQ2d 1818, 1820 (Bd.Pat.App & Interf. 1988). *See* MPEP 2143.01(I).

The Examiner has failed to point to an objective teaching in Zigmond, Doherty or in the knowledge generally available to one of ordinary skill in the art at the time of the claimed invention that suggests the desirability of combining these references. Initially, Applicants point out that Zigmond does not teach or suggest the use or determination of an ordered list, schedule or queue for displaying advertisements, nor does Zigmond teach or suggest the modification of such an order or queue. Zigmond's system also does not need nor contemplate the need for an ordered list or advertisements.

The Examiner has not pointed to, nor is there, any objective teaching in Zigmond to suggest the addition of an ordered list (and the modification thereof) to Zigmond's

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system. The Examiner has repeatedly argued that motivation to combine is provided by Doherty's ability to "compile and prepare advertisements in advance to eliminate any possible delay" (Non-Final Rejection, pages 11-12). However, even if such a teaching is found in Doherty, one skilled in the art would not necessarily think to add a schedule and a modification thereof (according to program content) as taught by Doherty to Zigmond's system. This is because Zigmond itself teaches an advertisement insertion system that already functions efficiently as disclosed. Moreover, Zigmond's system already has the ability to select the desired advertisement(s) "on demand", thereby obviating the need for a modifiable schedule or queue as suggested by the Examiner.

Merely pointing out the existence of particular teachings in one reference is not sufficient to establish that there would be a motivation to combine that reference with another. The burden is on the Examiner to provide a convincing line of reasoning, based on knowledge generally available to one of ordinary skill in the art, established scientific principles or legal precedent, that there would have been a motivation to combine Zigmond and Doherty. *See* MPEP 2144. As such, the Examiner has not established that there is a motivation to modify or otherwise combine Zigmond and Doherty. Accordingly, the proposed combination of Zigmond and Doherty is improper.

ii. The Proposed Combination Does Not Teach or Suggest All Claim Elements

When making a rejection under 35 U.S.C. § 103, the prior art references, when combined, must teach or suggest all of the claim limitations. *See* MPEP 2143.03. The combination of Zigmond and Doherty, even if proper, still does not teach or suggest all of the features of Applicants' claims.

Initially, Applicants disagree with the Examiner's assertion at page 9 of the Non-Final Rejection that Applicants have argued against the obviousness rejection by attacking the references individually. Rather, Applicants have repeatedly pointed out that the references do not teach or suggest the features as contended by the Examiner, and, therefore, cannot possibly teach or suggest such features when combined.

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Applicants also disagree with the Examiner's continued assertion that the combination of Zigmond and Doherty teaches the modification of an order, schedule or queue according to the displayed program content (Non-Final Rejection, pages 10-11), as recited in independent claims 4 and 90. Specifically, Applicants disagree with the Examiner's reading of Doherty, and in particular the Examiner's interpretation of the schedule modification discussed therein, which the Examiner relies on to assert that the combination of Doherty with Zigmond teaches all elements of Applicants' claims.

Doherty, however, does not teach that the schedule discussed therein is altered *based upon* the user's interactions. Rather, Doherty's schedule is altered *in response to* a user interaction. The Examiner cites paragraph 30 of Doherty for the proposition that Doherty teaches altering of a schedule based upon user interactions (Non-Final Rejection, page 4). However, this relied on portion of Doherty merely states that the "schedule is cleared and rescheduling is undertaken" in response to a user interrupt (see paragraph 30 of Doherty). Doherty goes on to describe on what basis the items of information may be prioritized: location, time, user profile and available time to compile the output. Accordingly, Doherty does not teach that the schedule is altered *based upon* the user's interactions. Thus, in Doherty, a user interrupt *triggers* the alteration of the schedule – but that interrupt does not dictate *how* the schedule is altered in response to that interrupt. Therefore, Doherty does not teach or suggest that any modification to the schedule is made based on or according to the actual user interaction.

Moreover, even if Doherty could be construed to teach altering the schedule based on the user's interactions, Doherty still does not teach or suggest altering the schedule or order "according to program content displayed as a result of the detected change," as recited in independent claims 4 and 90. That is, the "current conditions" that Doherty's system uses to prioritize advertisements and generate a schedule do not include the currently displayed program content (be it program content displayed before or after a detected change in the content). Thus, Doherty does not teach or suggest that the new or altered schedule is in any manner dependent on program content that is displayed as a result of a change in program content.

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Even though the Examiner relies on Zigmond for the teaching of altering the schedule according to program content, such a teaching does not make up for the deficiencies of Doherty's schedule, since Doherty does not teach or suggest that the new or altered schedule is in any manner based on or modified according to the actual user interaction. Thus, Doherty's schedule, even when placed in combination with Zigmond, is not reordered or modified according to program content displayed as a result of the detected change, as recited in the independent claims. Accordingly, since Doherty does not teach or suggest the features recited in independent claims 4 and 90, as argued by the Examiner, the combination of Doherty with Zigmond, even if proper, still lacks such a teaching.

Furthermore, even if the references are combined as argued by the Examiner, such that Zigmond's teaching of "selecting advertisements based upon the current viewed program" is sufficient to satisfy the noted deficiencies of Doherty's schedule, such a combination still lacks a teaching of modifying "the order in which the unscheduled advertisements are to be inserted according to program content displayed as a result of the detected change." Stated differently, the fact that Zigmond may teach selecting advertisements based on currently viewed programming does not mean that the resulting combination of Zigmond and Doherty teaches an ordered list or queue that is reordered according to the different program content – even if one or both of these references detects a triggering event (e.g., a change in program content) and takes action as a result of that triggering event. Zigmond simply does not contemplate the use of a schedule, ordered list or queue. Thus, Zigmond itself cannot be relied on to teach reordering a queue, and certainly not to reorder a queue according to different program content. As such, even if Doherty's queue were incorporated into Zigmond's system, it cannot be inferred from such a combination that the included queue will be reordered at all, let alone according to program content. As such, the Examiner is simply not entitled to assume that such a modification will occur nor use improper hindsight to contend that the resulting combination would include this feature. Simply put, there is no suggestion of a queue reordered according to program content in a combination of Zigmond and Doherty. Accordingly, the Examiner has still not pointed to any individual or combined

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teaching that suggests modifying "the order in which the unscheduled advertisements are to be inserted according to program content displayed as a result of the detected change," as recited in independent claims 4 and 90.

In view of the foregoing, Applicants respectfully submit that the combination of Zigmond and Doherty is thus improper since the Examiner has not pointed to an objective teaching which suggests the motivation to combine them. Even assuming the references were properly combinable, which they are not, all features of the claims would still not be taught by the combination. Therefore, the Examiner has not met the burden of *prima facie* obviousness. Accordingly, for the reasons detailed herein, independent claims 4 and 90, and all claims dependent thereon, including claims 5, 6, 55, 56, 59, 60, 75, 78, 79 and 91, are allowable over the combination of Zigmond and Doherty.

Conclusion

For the reasons set forth above, Applicants submit that the rejection of claims 4-6, 55, 56, 59, 60, 75, 78, 79, 90 and 91 is in error, and that the application, including claims 4-6, 55, 56, 59, 60, 75, 78, 79, 90 and 91, is in condition for allowance. Accordingly, Applicants respectfully request that the Board reverse the Examiner's rejections of claims 4-6, 55, 56, 59, 60, 75, 78, 79, 90 and 91 and remand this application for issue.

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(H) CLAIMS APPENDIX

1-3. (canceled)

4. (previously presented) A subscriber system for inserting unscheduled advertisements into at least one channel of media signals, the system comprising:

an ad insertion device configured to determine an order in which the unscheduled advertisements are to be inserted into the at least one channel and insert the unscheduled advertisements into the at least one channel according to the order; and

a watchdog module coupled to the ad insertion device, the watchdog module configured to detect a change in current program content being displayed on the at least one channel and output results of the detection to the ad insertion device, such that the ad insertion device modifies the order in which the unscheduled advertisements are to be inserted according to program content displayed as a result of the detected change.

5. (previously presented) The system of claim 4, further comprising:

a remote control device in communication with the watchdog module, wherein the watchdog module detects change in the program content based on outputs from the remote control device.

6. (previously presented) The system of claim 5, wherein the watchdog module detects change in the program content based on program information and outputs received from the remote control device.

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7-54. (canceled)

55. (previously presented) The system of claim 4, wherein said ad insertion device determines if a particular change in the currently displayed program content is sufficient to modify the order.

56. (previously presented) The system of claim 4, further comprising a tuner configured to tune to a channel selected by the subscriber, wherein said watchdog module detects change in program content by monitoring what channel the tuner is tuned to.

57-58. (canceled)

59. (previously presented) The system of claim 4, further comprising a profiler configured to process subscriber interactions and generate a viewing session profile, wherein the viewing session profile defines characteristics related to the subscriber for a viewing session.

60. (previously presented) The system of claim 59, wherein said watchdog module detects changes to viewing session profiles and wherein the ad insertion device also modifies the order based on changes to the viewing session profiles.

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61-74. (canceled)

75. (previously presented) The method of claim 90, wherein said detecting in step (d) occurs by monitoring what channel the subscriber is viewing.

76-77. (canceled)

78. (previously presented) The method of claim 90, further comprising:

(f) profiling subscriber interactions in order to generate a viewing session profile, wherein the viewing session profile defines characteristics related to the subscriber for a viewing session.

79. (previously presented) The method of claim 78, wherein step (d) includes detecting changes to viewing session profiles and wherein reordering of the queue in step (e) is also based on changes to the viewing session profiles.

80-89. (canceled)

90. (previously presented) A method of presenting targeted advertisements to a subscriber viewing current program content on a display device, the method comprising:

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- (a) generating a queue having unscheduled targeted advertisements to be presented to the subscriber, the queue indicating an order in which the advertisements are to be presented;
- (b) detecting an advertisement space associated with the current program content;
- (c) presenting the targeted advertisements to the subscriber in the detected advertisement space in accordance with the order;
- (d) detecting a change in current program content being displayed to the subscriber; and
- (e) reordering the queue according to program content displayed as a result of the change detected in step (d).

91. (previously presented) The method of claim 90 wherein the queue is reordered in real time.

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(I) EVIDENCE APPENDIX

None.

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(J) RELATED PROCEEDINGS APPENDIX

None.

Respectfully submitted,

Date: 1/19/07

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